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A0000104-01-SMH  
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## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

APPLICANT : Stephen Douglas Barrett, et al. EXAMINER : Shengjun Wang  
SERIAL NO. : 10/031,149 ART UNIT : 1617  
FILED : June 3, 2002 PAPER NO. :  
FOR : Method for Treating Chronic Pain Using MEK Inhibitors

## Response to Restriction Requirement Under 35 U.S.C. 121 and 372

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action dated October 3, 2003 in which Restriction was required under 35 U.S.C. 121 and 372.

Under PCT Rule 13.1 and in accordance with 37 CFR 1.499, Applicants were required to elect a single invention of the following inventions:

**Group I**, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is tetraazole (formulae viii and xvii).

**Group II**, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is triazole (formulae ix, x, xi, and part of i).

**Group III**, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is diazole (formulae ii, iii, part of iv, xii, xiii, xiv).

**Group IV**, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is oxazole (formulae v, vi, and part of iv, xii, xiii).

**Group V**, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is thiazole (part of formulae iv, xii, xiii, xiv).

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**Group VI**, claim(s) 31-32, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is not a heterocyclic moiety.

**Group VII**, claim(s) 1-31, drawn to a method of treating pain by using the compounds with formula (I), wherein the W is a heterocyclic moiety other than those defined in groups I-V.

The Applicants hereby elect Group VII for prosecution on the merits, without traverse.

The Applicants have also been required to elect a single species to which the claim shall be restricted if no generic claim is finally held to be allowable. The Applicants hereby elect the species (2,3-Difluoro-6-[1,3,4]oxadiazol-2-yl-phenyl)-(4-iodo-2-methyl-phenyl)-amine. Claims 1-9, 11, 14, 20, 23, and 32 are readable on the elected species.

Finally, the Applicants respectfully reserve the right to file a Divisional application(s) to the non-elected claims.

The Applicants submit that this application is now in condition for allowance, which allowance is respectfully solicited.

Respectfully submitted,

Dated: December 24, 2003



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Customer No. 28880

Confirm. No.: 8665

DEC 24 2003

Please type a plus sign (+) inside this box → PTO/SB/21 (8-98)  
Approved for use through 09/30/2000, OMB 0651-0031  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission **5**

Application Number	10/031,149
Filing Date	June 3, 2002
First Named Inventor	Stephen Douglas Barrett, et al.
Group Art Unit	1617
Examiner Name	Shengjun Wang
Attorney Docket Number	A0000104-01-SMH

## ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Certificate of Transmission under 37 CFR 1.8
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm  
or  
Individual name **Suzanne M. Harvey**Signature Date **12/24/03**

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: **12/24/03**Typed or printed name **Beth N. Gaines**Signature Date **12/24/03**

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PTO/SB/17 (01-03)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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# FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$ 420.00)

Complete if Known	
Application Number	10/031,149
Filing Date	June 3, 2002
First Named Inventor	Stephen Douglas Barrett, et al
Examiner Name	Shengjun Wang
Art Unit	1617
Attorney Docket No.	A0000104-01-SMH

## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money Order  Other  None

 Deposit Account:

Deposit Account Number: **23-0455**  
Deposit Account Name: **Warner-Lambert Company LLC**

The Commissioner is authorized to: (check all that apply)

Charge fee(s) indicated below  Credit any overpayments

Charge any additional fee(s) during the pendency of this application

Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 750	2001 375	Utility filing fee	
1002 330	2002 165	Design filing fee	
1003 520	2003 260	Plant filing fee	
1004 750	2004 375	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1)</b>		<b>(\$ 0.00)</b>	

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			-20** =	0 X \$18.00 =	0.00
			- 3** =	0 X \$56.00 =	0.00
				0.00 =	0.00

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 84	2201 42	Independent claims in excess of 3
1203 280	2203 140	Multiple dependent claim, if not paid
1204 84	2204 42	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
<b>SUBTOTAL (2)</b>		<b>(\$ 0.00)</b>

\*or number previously paid, if greater. For Reissues, see above

## 3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	420.00
1252 410	2252 205	Extension for reply within second month	
1253 930	2253 465	Extension for reply within third month	
1254 1,450	2254 725	Extension for reply within fourth month	
1255 1,870	2255 985	Extension for reply within fifth month	
1401 320	2401 160	Notice of Appeal	
1402 320	2402 160	Filing a brief in support of an appeal	
1403 280	2403 140	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,300	2453 650	Petition to revive - unintentional	
1501 1,300	2501 650	Utility issue fee (or reissue)	
1502 470	2502 235	Design issue fee	
1503 630	2503 315	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 750	2809 375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 750	2810 375	For each additional invention to be examined (37 CFR 1.129(b))	
1801 750	2801 375	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify)			
*Reduced by Basic Filing Fee Paid			
<b>SUBTOTAL (3)</b>		<b>(\$ 420.00)</b>	

(Complete if applicable)

Name (Print/Type)	Suzanne M. Harvey	Registration No. (Attorney/Agent)	42,640	Telephone 734-622-2658
Signature	Suzanne M. Harvey			Date 12/24/2003

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A0000104-01-SMH

PTO/SB/07 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

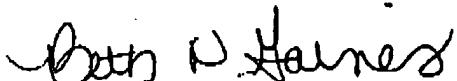
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## Certificate of Transmission under 37 CFR 1.8

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Date



Signature

Beth N. Gaines

Typed or printed name of person signing Certificate

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No. of Pages 5

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